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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,283	11/14/2003	Eric Garland	7330.P001	2048
8791 7590 09/22/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
ROBINSON, Greta Lee				
ART UNIT		PAPER NUMBER		
2169				
MAIL DATE		DELIVERY MODE		
09/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/714,283

**Applicant(s)**

GARLAND ET AL.

**Examiner**

Greta L. Robinson

**Art Unit**

2169

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 9/14/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24, 2009 has been entered.
2. Claims 9-16 and 24-30 are pending in the present application. Claims 9 and 24 were amended. Claims 1-9, 17-23 and 31-43 have status cancelled.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on September 14, 2009, has been considered by the examiner, note attached copy of form PTO-1449.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9 the following limitation is vague: "a transfer device adapted to intercept the list of all shared files from each computer of the plurality of computers and automatically store the list of all shared files in the database. The term "intercept" used in the phrase is vague. As presently written the function of the term appears to mean "transfer" of information into storage, as opposed to a specific interception of an action being performed.

6. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Regarding claims 9-16 the concept of *files being copied after interception* is omitted. Note support for this limitation can be found at paragraph [0070], which reads as follows, "Inventory is copied to database 1014 at step 1126". See Figure 11.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 24-26 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta et al. US Patent Application Publication No. 2002/0138471 A1.

As per independent claim 24 Dutta teaches:

coupling a computer to a database, the database to store lists of shared files available from peer computers on the peer-to-peer file-sharing network [see: fig.4, paragraph 70 and 0066];

coupling the computer to the peer-to-peer file-sharing network [see: fig.4, paragraph 70 (client rating database)];

locating a plurality of computers connected to the peer-to-peer file-sharing network by IP address [see: paragraph 71, lines 4-5];

requesting a listing of an entire library of shared files from each of said plurality of computers connected to the peer-to-peer file-sharing network [see: paragraph 59, lines 1-4];

receiving the listing of the entire libraries of shared files from the computer ... automatically storing the listing .... [see: paragraph 60, lines 1-4, paragraph 0041 and paragraph 0070]  
returns requested files in peer node in response to retrieval requests.

As per claim 25, same as claim arguments above and Dutta teaches:

further comprising adding source information to each of the listings at paragraph 71. As

As per claim 26, same as claim arguments above and Dutta teaches:  
wherein the source information comprises the geographic location of a computer  
where the library is stored at paragraph 71.

As per independent claim 9 Dutta teaches:  
a computer coupled to the peer-to-peer file-sharing network [see: fig.4, paragraph 70];  
a database to store information about files available on the peer-to-peer file-sharing network  
coupled to the computer at fig.4, paragraph 0066 ratings module monitors events [see:  
paragraph 70 (client rating database)];  
a query device adapted to request a list of all shared files from a plurality of computers  
connected to the peer-to-peer file sharing network [see: paragraph 59, lines 1-4];  
and a transfer device adapted to intercept the list of all shared files  
from each computer of the plurality of computers and automatically store the list of shared  
files in the database, thereby tracking file storage on the peer-to-peer file-sharing network  
[see paragraph 60, lines 1-4, also note *shared file list* 264 paragraph 0041, paragraph 0066,  
0059 obtains copy and stores in database; paragraph 0064 software component may be  
extendable API and paragraph 0065 plug-in routines may be implemented to coordinate  
routines and retrieve dynamically].

With respect to claim 10, same as claim arguments above and Dutta teaches:  
further comprising an inventory preparation server coupled to the database at  
paragraph 71(client ratings database) and parag. 77, lines 11-13, rating server.

As per claim 11, same as claim arguments above and Dutta teaches:  
further comprising an archiving system coupled to the database, the archiving system to store  
at least one copy of the plurality of lists at paragraph 71(client ratings database).

As per claim 12, same as claim arguments above and Dutta teaches:  
further comprising an inventory processing server coupled to the database at paragraph 71.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of  
the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of  
the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

11. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 29-30 same as claim arguments above, however Dutta do not explicitly



teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

### ***Response to Arguments***

12. Applicant's arguments filed August 24, 2009 have been considered but they are not persuasive.

In the response Applicant argued the claims have been amended to overcome the rejections. Specifically claims 9 and 24 have been amended to specify the database is to store lists of shared files available from peer computers on a peer-to-peer network and that the claimed system or method receives the list of shared files. In response to applicants amendment the examiner respectfully maintains the prior art rejection. Dutta provides for the ability to receive an entire library of shared files [see: paragraphs 006-007 and 070 distributed file-sharing system supports peer-to-peer model for exchanging data. Each node has a list of addresses that can directly communicate with each other. Each peer node searches its own database to satisfy the query. Copies the query to each node in its list of peer nodes. Dutta teaches an alternative (264) list of shared files which may be imported and exported see paragraph 0041 and Figure 2C sharable file list element 264. O'Kane teaches devices in a file sharing environment for tracking and regulating process see paragraph 0062-0063. Regarding independent claim 9,

Applicant argues prior art reference does not teach tracking file storage or a transfer device adapted to intercept the list of shared files. Dutta provides for tracking of file storage. Note Dutta is directed to monitoring file activities and teaches monitoring may vary depending on the software architecture see paragraph 0064. The system can snoop on traffic and can monitor directories in which system downloads or deletion is to take place (i.e. monitoring storage ability) see paragraph 0066. Dutta teaches the processor 322 monitors actions and can perform various functions to determine how and when files are retrieved see paragraph 0066. Also note paragraph 0059 states the processor 322 makes a copy of the files and stores them in the ratings database.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bober US Patent 6,718,372 B1

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571)272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/  
Primary Examiner, Art Unit 2169  
September 18, 2009